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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,711	11/17/2000	Hamilton Dorest		4821

7590 08/05/2003
Kenneth D Baugh
2413 Blodgett
Houston, TX 77004

EXAMINER

JOHNSON, BLAIR M

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,711

Applicant(s)

DOREST, HAMILTON

Examiner

Blair M. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

INTRODUCTION

Applicant has filed of a "Continued Prosecution Application (CPA) Request Transmittal" on 6/23/03. In so doing, Applicant has expressly abandoned the previous prosecution of this application (09/714711) in favor of the CPA, which is considered to be a Request for Continued Examination (RCE). Applicant has made reference to a continuation in part application (CIP). However, a CIP has not been properly filed. As stated on the Request Transmittal referenced above, the application has been expressly abandoned and that 37 CFR 1.53b must be used to file a CIP. Since the application was under appeal, Applicant's appeal has been abandoned.

Applicant's new specification is considered a substitute specification. As such, it contains new matter and will not be entered in accordance with 37 CFR 1.125(b).

Applicant's drawings contain numerous changes which (1) have not been made in accordance with Office policy (i.e. changes in red, etc.), and (2) contain new matter. Consequently, since the new drawings are considered to be drawing corrections, they have not been approved.

Since the claims as of the amendment of 1/10/02 (the amendment of 10/10/02 being not entered after final and a request for such entry in the Request Transmittal lacking) are still pending (claims 1-10,13-18), the new claims 1-16 have been renumbered as 19-34, rule 1.121.

If Applicant wishes to file a new CIP application with a new serial number, he may petition under 37 CFR 1.182 requesting that the substitute specification be

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removed from the RCE application file and be accorded the status as a separate application by being placed in a new file and given a new application number.

The following is an action on claims 1-10 and 13-34. The rejection of claims 1-10 and 13-18 is repeated from the final rejection of 3/20/02. Claims 19-34 are rejected under 35 USC 112(1) as containing new matter.

Claim Rejections - 35 USC § 112

Claims 1-10 and 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 10: lines 4 and 10 respectively, there is no antecedent basis for "the first portions". In claim 1, in line 8, it is not clear if "in first and second portions" is referring to same "first portions" in line 4; the second transparent member is said to be able to be movable in the second rectangular tracking member so as open and close the second portions of the opening. However, it is not clear how one transparent member (second) can cover the entire opening.

In claim 3, it is not clear which opening is "the opening", line 6.

Claims 3-10 and 13-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The intermediate member has not been adequately disclosed or shown.

Claims 19-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19-34 contain new matter and further are ambiguous since the substitute specification from they find basis has not been entered. For example, the "horizontally extending members having a downward pitch and apertures formed thereon" and the "coupling members" constitute new matter and are not disclosed in the original specification.

Claim Rejections - 35 USC § 103

Claims 1-10 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruby et al.

See base support member 12,14,16,18; tracking members, which are the elements which define tracks 82,84,118,120, and are aligned in "portions" of the opening; transparent members 20,30, each coupled in respective tracking member. Both transparent members may be slid to open and close the window. While Ruby et al provides a nailing fin, Fig. 9, as part of his base support member, it is not disclosed if the nailing fin has spaced apertures. However, such is well known in the art and

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therefore, providing apertures for the fasteners which go through the nailing fin would have been well within the purview of one of ordinary skill in the art.

Regarding claim 2, the upper frame member has portions which "cover" the transparent members.

Regarding claim 3, etc., the frame member 34 constitutes an intermediate member as broadly recited.

Regarding claims 3 and 4, the base members 12,14,16,18, have numerous flanges, sides, etc., which meet the limitations of various horizontal, vertical, and perpendicularly oriented members.

Specification

The use of P[p]lexiglass TM in windows is well known in the art and it would have been obvious to replace the glass of Ruby et al with plexiglass so as to render the window more damage resistant and lighter in weight.

The use of the trademark Plexiglass has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blair M. Johnson whose telephone number is (703) 308-0526. The examiner can normally be reached on Mon.-Fri., 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.



Blair M. Johnson

Primary Examiner
Art Unit 3634

BMJ
August 4, 2003